

Applicant: Joachim Schicke
Appl. No. 10/038,575

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-44 are pending in the application, with claims 1, 24, 36, 37, 40, 42 and 44 being the independent claims.

Acknowledgement of Allowed Subject Matter

The indication that claims 23 and 26 contain allowable subject matter is gratefully noted.

Rejections under 35 U.S.C. § 103

Claims 1-22, 24, 25 and 27-44 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 3,830,126 to Ringe in view of U.S. Patent 5,217,424 to Pallmann or U.S. Patent 975,563 to Morgan. Reconsideration is respectfully requested.

Initially, it is noted that the Action rejects 42 separate claims in less than one page. The Action fails to describe how the primary or secondary references relied upon teach virtually any of the claimed features. As such, it is difficult for the Applicant to have a fair opportunity to respond to the rejection. Further complicating the situation is the fact that the Action appears to cite two, alternative secondary references as teaching most of the claimed features. It is unclear whether each of the references are cited for teaching all of features individually or if both references in combination are cited for teaching the claimed features. Clarification and an

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explanation of how the references teach each of the claimed features are respectfully requested.
(See MPEP 706.02(j): “It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.”)

Ringe is the primary reference and is only cited for teaching “it is known to provide a ‘smoker’s products’ producing apparatus cutter with a knife blade that is discrete and exchangeable.” Reconsideration of the teachings of Ringe is respectfully requested.

Ringe does not teach a cutter with a knife blade that is discrete and exchangeable. Col. 5, lines 9-19 states: “The cutoff 21 further comprises a substantially cylindrical streamlined housing 27 for a holder 26 which supports a knife 28. The housing 26 rotates in the direction indicated by the arrow and the holder 26 for the knife 28 is mounted in such a way (by one or more universal joints and in a manner known from the art of cutoffs for cigarette rods or the like) that the orbiting knife 28 has a component of movement in the direction indicated by the arrow 32 at the time its cutting edge severs the rod 19 in the space between two coaxial tubes 29, 31 of the guide 22.” Thus, only a passing, parenthetical reference of how the holder is mounted is disclosed in Ringe. There is no teaching that the holder is discrete and exchangeable, and more importantly, there is no teaching at all about discrete and exchangeable knife blades or that the knife blades can be replaced at all. In other words, Ringe fails to disclose that the knife blades are replaceable even manually.

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Accordingly, the rejection based on Ringe is improper and should be withdrawn.

Furthermore, the Action proposes to modify the apparatus of Ringe with the teachings of Morgan or Pallman.

Morgan and Pallman are non-analogous art with respect to the present invention and Rinke, and thus, should not be relied upon as a basis for rejection of the Applicant's invention. To be considered analogous art, the references must either be in the field of the Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. Morgan is directed to a bit changing apparatus for mining machines, wood-working machinery, and metal-working tools, and Pallman is directed to wood flaking machines. Thus, it is clear that the cited references are not within the field of the Applicant's endeavor, i.e., manufacturing tobacco products. Furthermore, the disclosures of Morgan and Pallman are not reasonably pertinent to any particular problem with which the invention was concerned. It is noted, in this context, that exchanging or replacing knife blades, without regard to the type of apparatus, is an impermissibly and unreasonably broad statement of the "problem." It is unreasonable to argue that a person of ordinary skill in the art, seeking to automate the replacement of knives for severing a smokers' product, would look to the wood-working machinery of Morgan or the wood flaking machines of Pallman. The apparatuses are simply too different. In *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1993), the Federal Circuit rejected the PTO's argument that all hooking and fastener problems were analogous and stated that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would not reasonably be

analogous art

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expected or motivated to look to fasteners for garments. See MPEP 2141.01(a). Similar to the situation of *Oetiker*, all cutting problems are also not analogous.

Even if one does consider Morgan and/or Pallman to be analogous art, one would not combine Morgan or Pallman with Ringe in the manner proposed by the Action.

First, as discussed above, Ringe does not teach to manually replace the knife blades. ✓
Thus, it cannot be obvious to automate the replacement of the blades. ✓
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Moreover, even if Morgan and Pallman are considered analogous art, the differences in the apparatuses would factor in the determination of whether one would be motivated to combine the references as proposed. Applicant understands that the test for obviousness is not whether the features of the secondary reference can be bodily incorporated into the structure of the primary reference. (MPEP 4145). However, it is difficult to conceive how even the teachings of Morgan or Pallman can be incorporated into the apparatus of Ringe. Clarification is respectfully requested on how the specific teachings of Morgan or Pallman would be incorporated into the specific apparatus of Ringe.

Finally, contrary to the allegation in the Action, it is noted Pallman does not replace the knife in the cutting apparatus, as required by the claims. Pullman removes the entire knife ring and places the knife in a separate exchange device to replace the knife blades.

Claims 1-22, 24, 25 and 27-44 are allowable over the cited art.

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Other Matters

It is noted that the Filing Receipt mailed February 7, 2002 lists the title as "METHOD OF AND APPARATUS FOR REPLACING CUTTING IMPLEMENTS IN SERVERING MACHINES." The correct title, as specified in the originally filed application, includes the word "SEVERING" instead of "SERVERING". Correction of the Patent Office records is respectfully requested.

Attached to the Office Action mailed January 16, 2003 was the PTO-1449 attached to the Information Disclosure Statement filed January 8, 2002. PTO-1449 includes the Examiner's initials as acknowledgement of consideration of Reference Cite Nos. AA-AF, but the Examiner failed to initial Reference Cite No. AG. In that the IDS filed January 8, 2002 complied all applicable rules and guidelines, it is presumed that the Examiner considered the reference but inadvertently failed to initial PTO-1449. Acknowledgement of consideration of Reference Cite No. AG is respectfully requested. An additional copy of PTO-1449 is enclosed for the Examiner's convenience.

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Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

A Notice of Allowance with claims 1-44 is respectfully requested.

Respectfully submitted,



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